

### **REMARKS/ARGUMENTS**

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Upon entry of this amendment, claims 4, 6-9, and 15-49 have been cancelled, and new claims 50-89 are pending. Accordingly, no greater number of claims will be pending after the entry of this amendment, than were previously pending. The above amendments will place the application in condition for allowance, or will simplify the issues on Appeal should the rejections be maintained. Therefore, entry of this amendment after final rejection is respectfully requested.

Claims 28-33 were withdrawn from consideration and claims 43-49 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In addition, claims 4, 38, 39, 42, 43 and 45-49 stand rejected under 35 U.S.C. §102(b) as anticipated by JP 04-096996, and claims 43, 45 and 47-49 stand rejected as anticipated by Sport-Horse Supreme. In order to expedite prosecution, these claims were cancelled, thereby rendering the above rejections moot.

Claims 4, 6, 7, 15, 16, 18-21, 24-27, 34 and 37-49 stand rejected as being anticipated by the Chaser<sup>TM</sup> publication, and claims 8, 9, 23, 35 and 36 stand rejected as being obvious under §103 over this reference. Furthermore, claim 17 stands rejected as obvious over Chaser in view of "goaskalice.columbia.edu : 'Hangover-Helping Product'", and claim 22 as obvious over Chaser further in view of Grant *et al.* Applicants traverse these rejections in light of the attached Rule 132 declaration of Thomas F. Morse and for at least the following reasons.

The MPEP defines a "Public use" under §102(b) as follows<sup>1</sup>:

"Public use" of a claimed invention under 35 U.S.C. §102(b) occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor.

As can be seen from the attached declaration of Mr. Morse, the use cited by the Examiner as public was certainly not without limitations, restrictions or the obligations of secrecy.

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<sup>1</sup> MPEP §2133.03(a)(B), quoting *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed Cir. 1983).

As indicated by Mr. Morse, “the use” in question is the experimental study of the effects and efficacy of the Chaser composition. These studies were conducted in a fashion that allowed the Applicants to retain control over their invention. The parties conducting the research were obligated to maintain the Chaser composition in confidentiality. Confidentiality agreements are “one factor to be considered along with the time, place, and circumstances of the use which show the amount of control the inventor retained over the invention.”<sup>2</sup> Here, the presence of a confidentiality agreement, executed by the parties conducting the research from revealing the Chaser formulation, evidences the intent of the Applicants to keep close control over their invention.

Furthermore, the studies themselves were conducted in a closed manner at the research facility under the direction and supervision of the research administrators. Accordingly, the evidence of record indicates the Applicants never intended to relinquish control over their invention and thus these studies were not a “public use.”

The Examiner cites the venerable case of *Egbert v. Lippman*, as precedent for the rule that “a single use in the public domain is sufficient to bar granting of a patent.” However, this wooden statement ignores the more basic inquiry of whether the use was *public* at all. For the reasons set forth above, the Applicants maintain that the use cited by the Examiner was never legally *public* because the Applicants made sufficient efforts to maintain control over the invention during its use. Accordingly, the Examiner’s next contention that an insufficient showing was made that the claimed use was *experimental*, fundamentally mischaracterizes the Applicants’ argument, which is that the use was not *public*.<sup>3</sup>

Accordingly, the Applicants request reconsideration and withdrawal of these rejections.

Since the prior art of record does not disclose or suggest the invention as disclosed and claimed herein, the present application is believed to be in condition for allowance, and such action is hereby solicited. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

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<sup>2</sup> MPEP §2133.03(a)(B), quoting *Moleculon Research Corp. v. CBS Inc.*, 793 F.2d 1261, 1265, 119 USPQ 805, 809 (Fed Cir. 1986).

<sup>3</sup> The Applicants, therefore, do not comment on whether the cited use would have been experimental or if the evidence of record is sufficient to find such an experimental use.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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Date: January 16, 2004  
Attachment: Declaration Under 37 C.F.R. 1.132 by Thomas F. Morse